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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/359,809	07/23/1999	RICHARD LEVY	01064.0011-0	3299

7590 05/14/2004

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EXAMINER

TOOMER, CEPHIA D

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 05/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

Office Action Summary	Application No. 09/359,809	Applicant(s) LEVY, RICHARD	
	Examiner Cephia D. Toomer	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 57-72 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 57-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>04/04</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1714

DETAILED ACTION

This Office action is in response to the appeal brief filed February 2, 2004 and the Information Disclosure Statement filed April 2, 2004. Applicant's arguments with respect to the prior art are deemed persuasive and the rejections under 35 USC 102 are withdrawn. The rejection of claims 57-72 under the judicially created doctrine of obviousness-type double Patenting in view of claims 29-43 and added claims 45-50, 52, 53, and 55-71 is maintained for the reason of record.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 59, 60, and 64-66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 59 and 60 are rejected because there is no antecedent support in claim 57 for "carbon or metal."

In claim 64, the recitation of oil or greases thereof and water does not find antecedent support in claim 57. The lubricant additive is not optional.

Claim 65 is rejected because claim 57 does not provide antecedent support for "a solid lubricant." The additive is not optional.

Claim 66 is rejected because claim 57 does not provide for a solid inorganic lubricant that is a metal. The lubricants must be compounds.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made

3. Claims 1, 57, 58, 61, 62, 69, 70, 71 and 72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman (US 5,218,011) in view of Le-Khac (US 4,616,063).

Freeman teaches a gel composition comprising a gel matrix, a thickener (soaps) and a water absorbent polymer (see abstract). The gel matrix may be silicones, petroleum gels, high viscosity esters (fatty oils), glycol, olefins, mineral oil and fluorocarbons (see col. 7, lines 19-39). The water absorbent polymers include polyacrylic, maleic acids, acrylates, acrylamide and acrylonitrile (see col. 5, lines 55-68; col. 6, lines 1-29). The gel composition also contains a rust inhibitor (see col. 9, lines 26-35). In Example 22, Freeman teaches a composition comprising white oil (petroleum oil), micro-crystalline wax and a water absorbent polymer that is of the type described in 4,616,063 (Le-Khac). Le-Khac teaches that the polymers of his invention have a water up take up to 16,000% (see Table, col. 6).

Freeman does not specifically teach that the polymers of his invention absorb greater than 100 times its weight in water. However, Le-Khac teaches that the polymer


Art Unit: 1714

illustrated in Example 22 of Freeman more than meets this limitation. Therefore, it would be reasonable to expect that the other polymers taught in Freeman would meet the limitation regarding the amount of water the polymers are capable of absorbing.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cephia Toomer whose telephone number is (571) 272-1126. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Cephia D. Toomer
Primary Examiner
Art Unit 1714

009/359809/041704